

### **REMARKS**

This communication is responsive to the Office Action mailed on May 20, 2004. No claims are amended, no claims are canceled, and no claims are added. As a result, claims 1-25 are now pending in this Application. The Applicants request the benefit of an Examiner's Interview prior to the preparation and mailing of any Final Office Action if the Office is not convinced that all of the pending claims are in condition for allowance after reviewing this document.

#### **Objection to the Application Title**

The title of the Application was deemed not to be descriptive by the Office. In response, the title has been amended and is believed to be essentially in accord with the title suggested by the Examiner (a shorter form than was originally suggested has been used to accommodate foreign filing considerations). The Examiner is encouraged to telephone the undersigned if the newly-amended title is still deemed unacceptable.

#### **§102 Rejection of the Claims**

Claims 1-11, 14-16 and 18-21 were rejected under 35 USC § 102(e) as being anticipated by Kinnunen et al. (U.S. 2001/0018349, hereinafter "Kinnunen"). The Applicants do not admit that Kinnunen is prior art, and reserve the right to swear behind this reference at a later date. In addition, because the Applicants assert that the Office has not shown that Kinnunen discloses the identical invention as claimed, the Applicants respectfully traverse this rejection of the claims.

It is respectfully noted that anticipation under 35 USC § 102 requires the disclosure in a single prior art reference of each element of the claim under consideration. *See Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, "[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*" *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485

(Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

With respect to independent claims 1 and 10, it is respectfully noted that Kinnunen is directed toward a service-discovery system based on advertising available services to potential users. See Kinnunen, Para. 74. User profiles are used to target particular services to various users. See Kinnunen, Para. 76. “Therefore, the user characteristics are examined and suitable services are targeted at them.” *Id.* Service views are created for all mobile units. “A service view is a dynamically created repository of service handles for each ME connected to the network. In short it represents the ‘set of services applicable to a user in a particular location’.” *Id.* at Para. 101.

While the assertion is made in the Office Action that Kinnunen discloses various elements of the claims, it is respectfully noted that Kinnunen actually operates as part of a service advertising environment, rather than a query-based environment. See Kinnunen, FIGs. 3 and 4, “notifications” element. In fact, Kinnunen is noted in the Office Action to operate by “subsequently obtaining the location information associated with the mobile terminal.” Office Action, Pg. 3, lines 8-11. Thus, Kinnunen does not teach “a mobile device ... capable of sending *a query including a service location associated with the current location* and at least one selected member of the list of preferred services to the service registry”, as claimed by the Applicants. Rather, Kinnunen operates to independently track the mobile station location and to publish location-available services prior to receiving a request from the mobile unit.

Similar considerations apply to claim 14, which includes “sending a first *query including a service location* ... and at least one selected member of a list of services ... to a service registry.” This type of operation is not taught by Kinnunen, which specifically notes that “[t]he notification framework updates the service view to the ME each time it changes on the network side. Thus the updates are automatic ...,” and not prompted by queries including location information. See Kinnunen, Para. 126.

It is respectfully noted that “The *identical invention* must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP § 2131 (emphasis added). Therefore, since what is disclosed by Kinnunen is not identical to the subject matter of the embodiments claimed, the

rejection of independent claims 1, 10, and 14 (as well as claims 2-9, 11, 15-16, and 18-21 that depend from them) under § 102(e) is improper. Reconsideration and allowance is respectfully requested.

§103 Rejection of the Claims

Claims 12, 13 and 17 were rejected under 35 USC § 103(a) as being unpatentable over Kinnunen in view of Hayduk (U.S. 2003/0054833, hereinafter "Hayduk"). Claims 22-25 were rejected under 35 USC § 103(a) as being unpatentable over Kinnunen in view of Lelievre et al. (U.S. 2003/0040272, hereinafter "Lelievre"). First, Hayduk can not serve as prior art under 35 USC § 103(c). Second, Lelievre can not serve as prior art under USC § 103(a), and the Applicants respectfully traverse these rejections.

The Applicants respectfully submit that Hayduk is not prior art with respect to any of the pending claims of the present Application. A reference asserted under § 102(e) that was commonly owned with an application at the time the invention was made cannot preclude patentability of the claims under 35 U.S.C. §103, where the application has been filed on or after November 29, 1999. *35 U.S.C. § 103(c); 1233 OG 55 (April 11, 2000)*.

The Application was filed on November 27, 2001, as shown by the attached copy of the Filing Receipt (see Appendix I). This filing date is after November 29, 1999. The Application was assigned to Intel Corporation. A copy of the recorded assignment is attached (see Appendix II). Further, the Applicants submit a copy of the recorded assignment for Hayduk, again to Intel Corporation, as proof of common ownership by the same person at the time the invention was made (Appendix III).

Hayduk and the Application were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person. Thus, Hayduk is commonly owned with the Application and is not prior art with respect to the pending claims of the Application. Since common ownership of Hayduk and the Application render the combination of Kinnunen and Hayduk moot, the Applicants respectfully request withdrawal of this rejection under 35 U.S.C. §103(a), and allowance of pending claims 12-13 and 17.

Finally, the filing date of the Lelievre reference is August 24, 2001. No other priority data is given. Respectfully referring the Office to the Rule 1.131 Affidavit attached hereto as

Appendix IV, it can be seen that the date of invention is established therein to be at least as early as May 7, 2001. Thus, the Lelievre reference is inapplicable as a prior art reference in accordance with M.P.E.P. § 715.

Therefore, since neither Hayduk nor Lelievre can serve as prior art with respect to the instant Application, a *prima facie* case of obviousness has not been established with respect to independent claims 10 and 14. This conclusion also applies with respect to dependent claims 12-13, 17, and 22-25, since any claim depending from a nonobvious independent claim is also nonobvious. It is therefore respectfully requested that the rejections of claims 12-13, 17, and 22-25 under 35 U.S.C. § 103 be reconsidered and withdrawn.

**CONCLUSION**

The Applicants respectfully submit that the claims are in condition for allowance and notification to that effect is earnestly requested. As mentioned above, the benefit of an Examiner's Interview is requested if needed, and the Examiner is invited to telephone the Applicant's attorney, Mark Muller at (210) 308-5677, or Applicant's below-named attorney at (612) 349-9592 to facilitate prosecution of this Application. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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By their Representatives,

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Date July 20, 2004

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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 20 day of July, 2004.

KACIA LEE  
Name

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